



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,282	03/24/2000	Selda Günsel	42053.6USPT	2884

24238 7590 07/26/2002

JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION  
1100 LOUISIANA  
SUITE 1800  
HOUSTON, TX 77002-5214

EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
----------	--------------

1773

DATE MAILED: 07/26/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

<b>Office Action Summary</b>	<b>Application No.</b> 09/534,282	<b>Applicant(s)</b> GUNSEL ET AL.	
	<b>Examiner</b> Kevin M Bernatz	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>14</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                 |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

2. Claims 1, 2, 11 – 14 and 23 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al. ('600 B1) in view of Venier et al. ('023), Venier, Casserly and Gunsell (IDS reference titled "Tris (2-Octyldodecyl)Cyclopentane, a Low Volatility, Wide Liquid-Range, Hydrocarbon Fluid") and Babb et al. ('547). Hereafter, this combination of references will be referred to as SVVB.

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on February 7, 2002 (Paper No. 12).

3. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over SVVB as applied above, and further in view of Patsidis et al. ('351).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on February 7, 2002 (Paper No. 12).

4. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over SVVB as applied above, and further in view of Venier and Casserly (IDS reference from Symposium on the Chem. of Lubricants).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on February 7, 2002 (Paper No. 12).

5. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over SVVB as applied above, and further in view of Sanechika et al. ('593) and Ng ('216).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on February 7, 2002 (Paper No. 12).

6. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over SVVB as applied above, and further in view of Tsuchiya et al. ('516) and Hayashi ('983).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on February 7, 2002 (Paper No. 12).

### ***Response to Arguments***

7. **The rejection of claims 1 - 37 under 35 U.S.C § 103(a) – SVVB either alone or in vi w of various ref rences**

Applicant(s) argue(s) that the specification discloses sufficient evidence of unexpected results over the prior art that the present claims are distinguished from the references of record. The examiner respectfully disagrees.

As indicated in the attached interview summary, the examiner notes that the argument of unexpected results is convincing for the single embodiment shown<sup>2</sup> in Table II. However, as discussed in the aforementioned interview, the claims must be commensurate in scope with the showing of unexpected results. Currently, the only showing of unexpected results is for ~ 0.1 wt% Pennzane X-2000 versus 0.1 wt% Z-DOL. It is uncertain from the specification what MW Z-DOL and/or Pennzane is used. Should applicants desire to pursue a showing of unexpected results commensurate in scope with the claims as written, comparison between cyclopentane, cyclopentene and cyclopentadiene versus Z-DOL of comparable (a) MW, (b) viscosity and (c) chain length would be required. For a range in MW, viscosity or chain length, a comparison at each end point to be claimed would be required. The examiner reminds applicants that support for these endpoints must be found in the present disclosure or may be added in a Continuation-in-Part (CiP) application based on the current application.

For each species that applicants wish to claim, at least one embodiment representative of the species must also be shown to produce unexpected results when compared to a Z-DOL of similar MW, viscosity and/or chain length (whichever applicants feel is the closest prior art). For very broad species where the properties may not be expected to be uniform through-out the substituents groups, additional comparison would be required. Applicants are invited to contact the examiner if any

Art Unit: 1773

questions arise with regard to what would be a sufficient comparison versus the prior art.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB  
July 24, 2002



STEVAN A. RESAN  
PRIMARY EXAMINER